

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claims 24, 30 and 37 have been amended in response to issues raised in the Office Action. Claims 24-44 remain pending in this application.

Turning to the Office Action, claims 30 and 37 were rejected under 35 U.S.C. §112, second paragraph, for the reasons given in paragraph (3) of the Action. In response, claims 30 and 37 have been amended to delete the redundant subject matter. Accordingly, this rejection has been obviated and should be withdrawn.

Claims 24-30 were rejected under 35 U.S.C. §112, second paragraph, for the reasons given in paragraphs (4a) and (4b) on pages 2-3 of the Office Action. Further, claims 31-44 were rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth in paragraph (5) of the Office Action. Reconsideration of these rejections is requested for the following reasons.

Claim 24 was amended to delete the word "composition" in line 4 thereof. Thus, the terminology in lines 1 and 4 is now consistent and proper antecedent basis exists in the claim.

In response to the issue raised in paragraphs (4b) and (5), Applicants point out that the legal standard for determining compliance with the second paragraph of 35 U.S.C. §112 is whether the claims reasonably apprise those of ordinary skill in the art of their scope. See In re Warmerdam, 33 F.3d 1354,1361, 32 U.S.P.Q.2d 1754,1759 (Fed. Cir. 1994). In determining whether this standard is met, the definiteness of the language employed in the claim should be analyzed, not in a vacuum, but in light of the teachings of the prior art and of the particular application

disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. In re Johnson, 558 F.2d 1008,1015, 194 U.S.P.Q. 187,193 (CCPA 1977).

Applicants respectfully submit that those of ordinary skill in this art, having read the present disclosure, would clearly understand that the present claims are not directed to an irradiated resist but to a non-irradiated resist having the property of being soluble in an organic solvent or aqueous developer in areas exposed to radiation and being insoluble to solvents and developer in areas not so exposed. The resist is formed from the composition. This interpretation is consistent with the description in the specification, for example, on page 9, lines 7-13 and page 10, lines 17-26.

There is a disclosure on page 11, lines 21-24 of the specification that a resist film formed from the composition may be heated to be a crosslinked film considerably resistant to a developing solution. Regardless of the technique used to provide the requisite properties to the resist, the claims are clear in their scope: a positive resist formed from a composition comprising the specified components and having the specified properties.

For at least the aforementioned reasons, the §112, second paragraph, rejections of claims 24-44 should be withdrawn. Such action is respectfully requested.

Claims 24-44 were rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,496,678 to Imai et al. in view of U.S. Patent No. 5,363,738 to Kondo et al., U.S. Patent No. 5,556,734 to Yamachika et al. and U.S. Patent No. 4,696,886 to Hanabata et al. The Examiner's rationale is set forth in paragraph (6) of the Office

Action. Reconsideration of this rejection is requested for at least the following reasons.

In light of the Examiner's comment in paragraph (7) of the Office Action, Applicants are submitting herewith copies of the three Declarations submitted in the parent application (Serial No. 09/418,368; now Patent No. 6,630,285) pursuant to 37 C.F.R. §1.132. The combined data presented in the declarations shows that resist films of the invention unexpectedly provided superior resolution, superior transparency and superior thermal stability in comparison to resist films representative of the cited art.

Accordingly, in view of the attached Declarations, the §103(a) rejection over Imai et al. '678 in combination with Kondo et al. '738, Yamachika et al. '734 and Hanabata et al. '886 should be withdrawn. Such action is earnestly solicited.

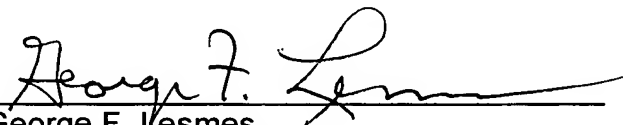
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at her earliest convenience.

Respectfully submitted,

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